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In re Application of
SIRIMANNE et al.
U.S. Application No. 09/869,282
PCT No.: PCT/US99/30619
Int. Filing Date: 23 December 1999
Priority Date: 24 December 1998
Atty. Docket No.: 412692000403
For: DEVICES AND METHODS FOR
MARKING OF A BIOPSY CAVITY (AS
AMENDED

DECISION ON PETITION
UNDER 37 CFR 1.47(a)

This is a decision on applicants' "Petition Under 37 CFR 1.47(a) to File on Behalf of Inventor Who Refuses to Execute Application" filed 27 February 2002 to accept the application without the signatures of joint inventor, D. Laksen Sirimanne. The required petition fee of \$130.00 (37 CFR 1.17(i)) has been submitted.

BACKGROUND

On 23 December 1999, applicants filed international application PCT/US99/30619 which claimed a priority date of 24 December 1998 and designated the United States. A Demand for international preliminary examination was filed prior to the expiration of nineteen months from the international filing date. Accordingly, the thirty-month period for paying the basic national fee in the United States was midnight, 25 June 2001 (24 June 2001 was a Sunday).

On 25 June 2001, applicant filed a transmittal letter for entry into the national stage in the United States, which accompanied by, inter alia: the requisite basic national fee as required by 35 U.S.C. 371(c)(1); the international application; and a preliminary amendment.

On 27 July 2001, the United States Designated/Elected Office mailed a Notification of Missing Requirements under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) must be filed. The notification set a two-month time limit in which to respond.

On 27 February 2002, applicant filed the present petition under 37 CFR 1.47(a) and a five-month extension of time.

DISCUSSION

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and behalf of the non-signing joint inventor. Items (1), (3) and (4) have been satisfied.

As to item (2), Section 409.03(d) of the Manual of Patent Examining Procedure (MPEP) states, in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of its refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application paper should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which the conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

A review of the present petition and the accompanying papers reveal that applicant has not satisfied the item (2) above. Petitioner has provided "Declaration of Steven Kim" which states that "[o]n September 10, 2001, I mailed application papers including Declarations to . . . D. Laksen Sirimanne. On January 22, 2002, I sent a second letter to D. Laksen Sirimanne again requesting execution of the Declaration." However, no documentary evidence to support the refusal or the attempt was provided with Mr. Kim's

declaration. Does "application papers" mean a complete copy of the application was mailed to the nonsigning inventor? Were the letter(s) returned as undeliverable? Was the letter(s) received by D. Laksen Sirimanne or by someone at the last known address?

In order to meet the requirements of 37 CFR 1.47(a) and Section 409.03(d) of the MPEP, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the application papers was sent to D. Laksen Sirimanne and when such papers were sent and that D. Laksen Sirimanne has subsequently refused to execute the application. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration.

For the reasons stated above, it would not be appropriate to accept the application without the signature of D. Laksen Sirimanne under 37 CFR 1.47(a) at this time.

CONCLUSION

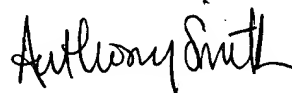
The renewed petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTH** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention to the PCT Legal Office.



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